

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA**

PRECIMED S.A. AND PRECIMED, INC.	:	CIVIL ACTION
	:	
v.	:	
	:	
ORTHOGENESIS, INC.,	:	No. 04-1842
	:	

**Memorandum**

**Baylson, J.**

**April 25, 2005**

Plaintiffs Precimed S.A. and Precimed, Inc. (“Precimed”) have brought an action for infringement of U.S. Patent Number 5,658,290 against Defendant Orthogenesis, Inc.’s (“Orthogenesis”). A summary of the factual allegations in Precimed’s complaint can be found in the Court’s Memorandum and Order of November 17, 2004, denying Defendant’s Motion to Dismiss for Lack of Personal Jurisdiction.

Presently before the Court are Precimed’s Motion to Strike the Fourth Affirmative Defense of Inequitable Conduct and to Dismiss the Counterclaim Incorporating Said Defense, filed on January 10, 2005. Orthogenesis’ opposition to the motion was filed on March 14, 2005, and Precimed filed a reply brief in support of the motion on March 24, 2005.

The Answer’s Fourth Affirmative Defense alleges that “[o]n information and belief, U.S. Patent No. 290 is unenforceable due to the inequitable conduct before the U.S. Patent and Trademark Office of the named inventors, their attorneys, and other [sic] involved in the preparation and prosecution of said patent in seeking issuance of the patent by failing to disclose to the Patent and Trademark Office information of which they were aware which was material to the examination of the application in violations of 37 C.F. R. Section 1.56.”

The counterclaim requests that the Court declare that U.S. Patent No. 290 is

unenforceable because “[o]n information and belief, U.S. Patent No. 290 is invalid and void under the provisions of Title 35 U.S.C. Section 101, 102, 103, 112, 115 and/or 116 and is unenforceable, as set forth specifically in the Affirmative Defenses of the Answer to which this Counterclaim is appended, all which are incorporated herein by reference.”

Precimed’s Motion argues that the Fourth Affirmative Defense must be stricken and the counterclaim must be dismissed because they fail to meet the pleading requirements of Rule 9(b) of the Federal Rules of Civil Procedure, which provides that “[i]n all averments of fraud or mistake, the circumstances constituting fraud or mistake shall be stated with particularity.” Fed. R. Civ. P. 9(b). In its response to Plaintiff’s motion, Orthogenesis concedes that the Fourth Affirmative Defense does not meet the pleading requirements of Rule 9(b) and requests that the Court strike the defense (Opposition to Motion to Strike, p. 1-2). Therefore, the Fourth Affirmative Defense will be stricken.

Orthogenesis opposes Precimed’s Motion to Dismiss the Counterclaim, however, on the grounds that the counterclaim does not allege “inequitable conduct” or “fraud,” but instead simply claims that the patent was “invalid” and “void,” and thus the pleading requirements of Rule 9(b) do not apply. Precimed argues that inequitable conduct “is pled and inferred in the counterclaim,” as the counterclaim incorporates by reference “all” of the affirmative defenses, including the claim of inequitable conduct, which Orthogenesis has conceded was improperly pled.

Because Orthogenesis incorporated all affirmative defenses into its Counterclaim, the fact that one of these affirmative defenses has been stricken itself warrants an Amended Counterclaim. The Court thus concludes that the counterclaim, as currently presented in

Orthogenesis' answer to the complaint, is at least in part predicated on the inequitable conduct defense, which has now been stricken, as no other factual allegations are made upon which the claim of the invalidity or voidness of the patent might be based. As there is no dispute that the particularity requirements of Rule 9(b) apply to inequitable conduct charges and Orthogenesis concedes it has not met those requirements, Plaintiff's motion will be granted. The Court will dismiss the counterclaim without prejudice, and Orthogenesis, if it so chooses, is given twenty (20) days to file an amended Counterclaim that includes additional factual allegations to support a claim that the patent is void and invalid for reasons other than inequitable conduct.

An appropriate order follows.

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**ORDER**

AND NOW this 25th day of April, 2005 upon consideration of Plaintiff's Motion to Strike the Fourth Affirmative Defense of Inequitable Conduct and to Dismiss the Counterclaim Incorporating Said Defense (Docket No. 20), and the responses thereto, and for the reasons stated in the foregoing Memorandum, it is ORDERED that the Fourth Affirmative Defense is stricken and that the Counterclaim is DISMISSED WITHOUT PREJUDICE, with leave to amend within twenty (20) days.

**BY THE COURT:**

/s/ Michael M. Baylson  
**Michael M. Baylson, U.S.D.J.**

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